

REMARKS

Claims 1 through 17 remain in the application. Applicants reserve the right to pursue the unelected subject matter of claims 1 through 17 in divisional applications. Reconsideration of the restriction requirement with respect to groups I and II is hereby respectfully requested.

The Examiner has imposed a four-way restriction in the present application (Groups I-V) as follows:

- Group I: drawn to unfused pyrimidine;
- Group II: drawn to bicyclopymidine;
- Group III: drawn to 1,3,5 triazine and 1,2,4-bicyclotriazine;
- Group IV: drawn to bicyclopymidine and bicyclopymidine;
- Group V: drawn to bicyclopymidine and pyridine.

Applicants elect Group I as drawn to unfused pyrimidine bearing an aminopyridine group, with traverse with respect to the restriction of Groups I through V and in particular to the restriction of Groups I and II. Applicants further elect the species 4-cyclopentylamino-2-(5-piperazin-1-yl-2-ylamino)-pyrimidine-5-carbonitrile for prosecution if no generic claim is finally held allowable. Applicants respectfully request that the restriction requirement with respect to Groups I through V, or at the very least, Groups I and II be withdrawn.

According to M.P.E.P. § 803 the Examiner can only restrict patentably distinct inventions when (1) the inventions are independent or distinct as claimed and (2) where there is a serious burden on the Examiner if restriction is not required.

1. **Burdensome Search and Examination**

Applicants respectfully submit that the Examiner has made no showing that prosecuting claims 1-7 in one application would be seriously burdensome. Applicants submit that searches for Groups I and II cannot be seriously burdensome. In discharging her obligation to conduct a diligent search, the Examiner must search all classes and subclasses that may have material pertinent to the subject matter as claimed. M.P.E.P. 904.02(a) states that:

"In outlining a field of search, the Examiner should note every class and subclass under the U.S. Patent Classification System and other organized systems of literature that may have material pertinent to the subject matter as claimed. Every subclass, digest, and cross reference art collection pertinent to each type of invention claimed should be included, from the largest combination through the various sub-combinations to the most elementary part. The fields of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed..." (emphasis added)

Clearly, the cited M.P.E.P. above suggests that the Examiner's field of search is not necessarily limited to one class and subclass. In the present case, Applicants submit that it is reasonable to

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expect that each of the classes and subclasses identified in Groups I through V, and in particular to Groups I and II, extend to areas relevant to the claimed subject matter of any other groups. Moreover, Applicants see that with respect to Group V, the Examiner is willing to search bicyclopriidines and pyridines in the same group, and request that at the very least, the Examiner search bicyclopriimidines (Group II) and pyrimidines (Group I) in the same group.

In view of the above, Applicants submit that the restriction requirement is improper and respectfully requests that the Examiner withdraw the restriction requirement so as to allow all heterocyclic groups of R¹ in claims 1-17 to be prosecuted in the same application.

2. Breaking up a Markush Group

Applicants for a patent have the right to define what they regard as their invention, so long as their definition is distinct, as required by the second paragraph of 35 U.S.C. 112, and supported by an enabling disclosure, as required by the first paragraph of 35 U.S.C. 112. In Re Hamish, 206 U.S.P.Q. 300, 305 (CCPA 1980). They also have the right to have each claim examined on the merits. In Re Weber, Soder and Boksay, 138 U.S.P.Q. 328, 331-32 (CCPA 1978). Restriction of the subject matter of a single claim in a patent application is therefore impermissible because it denies the Applicants their right to have the restricted claim examined on the merits. Id. at 331. As the court stated in Weber, "[i]f ... a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits." Id.

Applicants submit that they have the right to define what they regard as, in the present case, the definition of R¹ restricted by the Examiner. Applicants notes that a variety of heterocyclic groups are commonly prosecuted in the same invention.

M.P.E.P. 803.02 states that:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits... In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Hamish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). (Emphasis added).

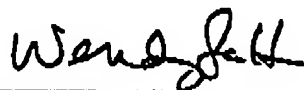
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Applicants respectfully submit that the subject matter in pending claims 1- 17 have unity of invention. Applicants submit that a search and examination of the heterocyclic groups in the same application can be made without serious burden. Applicants submit that it is improper for the Examiner to refuse to examine that which applicants regard as their invention. Applicants respectfully request that claims 1-17, as drawn to different heterocyclic groups pyrimidine, bicyclic pyrimidines, triazines and bicyclotriazines, bicyclopriazines, bicyclopriazines, bicyclopriazines and pyridines, be examined on the merits.

Respectfully submitted,



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